



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of
Ming-Fong Lin et al.
Serial No.: 09/919,196
Filed: July 31, 2001
For: "NOVEL PROSTATE CANCER
CELL LINES"

) Examiner: DAVIS, Minh Tam B
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) Art Unit: 1642
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) Response to Paper No. 7
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AMENDMENT AND REQUEST FOR

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RECONSIDERATION UNDER 37 C.F.R. §1.111

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Introductory Comments:

The January 27, 2003 Official Action and the references cited therein have been carefully reviewed. In view of the amendments, Declaration and remarks submitted herewith, favorable reconsideration and allowance of this application are respectfully requested.

At the outset, it is noted that the Examiner has maintained the restriction requirement issued with October 1, 2002 Official Action. Thus, claims 1-4 are currently under examination. It is also noted that the Examiner has withdrawn the requirement for further election of species among cell lines NE-1-3, NE-1-8, and NE-1-9.

At page 3 of the present Official Action, the Examiner has objected claim 4 under 35 U.S.C. §112, first paragraph, as allegedly failing to 1) provide an adequate written description of the invention and 2) an enabling disclosure.

At page 5, the Examiner further rejects claims 2 and 3 under 35 U.S.C. §112, first paragraph, as the specification allegedly fails to provide an affidavit or declaration stating that all restrictions upon public access to the deposits will be irrevocably removed upon the granting of a patent on the present application and that the deposit will be replaced if

viabile samples cannot be dispensed by the depository.

Claims 2-4 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

At page 6, the Examiner has rejected claims 1-4 under 35 U.S.C. §112, first paragraph, as the specification allegedly fails to provide enablement for cell lines NE-1-3, NE-1-8 or NE-1-9 stored in any medium.

At page 7, claim 1 has been rejected under 35 U.S.C. §102(b) as allegedly anticipated by Cox et al. (*Cancer Research* 1999;59:3821-3830), or Burchardt et al. (*The Journal of Urology* 1999;162:1800-1805), or Shen et al. (*Urologic Oncology* 1997;3(2):67-75).

The foregoing constitutes the entirety of the rejections raised in the January 27, 2003 Official Action. In light of the foregoing amendment, the following remarks, and the Declaration of Dr. Lin, attached hereto, each of the above-noted rejections under 35 U.S.C. §§102(b) and 112, first and second paragraphs, is respectfully traversed.